

defective Reissue Declaration. Attached herewith is a Supplemental Reissue Declaration addressing the objections raised by the Examiner in paragraphs 1-4 of the Office Action. Particularly, the Supplemental Reissue Declaration addresses the amendments set forth in the Amendment filed responding to the February 17, 1995 Office Action, the February 1, 1996 Office Action and the March 11, 1997 Office Action.

Further, the Supplemental Reissue Declaration distinctly specifies the insufficiency in the claims of U.S. Patent No. 4,975,857 and points out that the currently pending claims are directed to such insufficiency.

Still further, the Supplemental Reissue Declaration particularly sets forth the error being relied upon as claiming less than Applicants had a right to claim and that the error arose due to the failure of the inventors and the Japanese Agent to fully appreciate and recognize that the invention could have been claimed more broadly. These errors were in fact committed by the inventors and the Japanese Agent. As set forth in the Declaration the U.S. Patent Attorneys were made aware of such errors during meetings held on the dates of November 16, through November 20, 1992 and provided advise concerning reissue applications. Thus, affidavits from the U.S. Attorneys are unnecessary.

Regarding the Examiner's question as to why twenty-three claims are required to correct errors in the eight original claims. The Examiner appears to not have read any

of the Declaration and appears to be merely seizing on issues without relating the issues to the statements that have been made in the Declaration. Twenty-three claims are required to correct the errors in the eight original claims for the very same reason that has been continually argued through the prosecution, which the Examiner seems to have forgotten. The twenty-three claims are directed to broader aspects of Applicants' invention to which the eight original claims were not directed. The Examiner is strongly urged to reread the Declaration and the prosecution history so that there will be no need to rehash matter that has already been argued. Thus, Applicants specifically traverse the need for providing extensive and unnecessary comments concerning each of the claims as to why the claims are being added when the purpose of the reissue application has been clearly stated as being to claim subject matter which was insufficiently claimed in the eight original claims of U.S. Patent No. 4,975,857.

In paragraph 5 of the Office Action the Examiner rejects claims 44-66 under 35 USC §251 as not being directed to the invention disclosed in the original application. The Examiner provides arguments in support of this rejection in paragraph 7 of the Office Action by referring to MPEP §1412.01. Therein the Examiner incorrectly alleges that:

"Only that which is the objective intent manifested by the original patent may be claimed. Based on a review of the original patent, it appears that the objective intent was to claim the disclosed architecture to reduce the size and cost of the apparatus."

From the above it is quite apparent that the Examiner has seized upon a small portion of MPEP §1412.01 without thoroughly reading the complete text MPEP §1412.01 and the intent of this particular section. Further the Examiner appears to be requiring Applicants to claim what would be considered an advantage of Applicants' invention "to reduce the size and cost of apparatus" rather than one of the statutorily defined classes of patentable subject matter as set forth under 35 USC §101.

MPEP 1412.01 specifically states that:

"Some disclosure in the original patent should evidence that Applicant intended to claim or that Applicant considered the material now claimed to be his or her invention."

Thus, what is necessary is clearly necessary in this situation is a disclosure of the subject matter sought to be claimed. The Examiner appears to be taking an almost incredible position by telling Applicants what their claimed invention should be, misdescribing the claimed invention and then arguing that Applicants did not claim the misdescription. Applicants' invention as clearly set forth in the disclosure of U.S. Patent No. 4,975,871 is not directed to some type of nebulous system which "reduces the size and cost of the apparatus" but is instead directed to the apparatus clearly illustrated, for example, in Figs. 1, 4 and 5. Each and everyone of the claims 44-60, which have been added by the present reissue application, read on the apparatus as illustrated in Figs. 1, 4 and 5 and such apparatus has been clearly described and disclosed in the

specification of U.S. Patent No. 4,975,857.

Therefore, when reading MPEP §1412.01, particularly the section identified by the Examiner, the objective intent manifested by the original patent can only correspond to "some disclosure in the original patent" evidencing "that Applicant intended to claim or that Applicant considered the material now claimed to be his or her invention". The operative word in this situation is disclosure not the objective of an invention which merely corresponds to intended results or advantages of the invention relative to the conventional apparatus. When the disclosure is reviewed it is readily apparent that claims 44-60 read on the disclosure and that such disclosure is evidence "that Applicant considered the material now claimed to be his [or her] invention" as per MPEP §1412.01.

The Examiner is glaringly in error in this regard and seems intent on forcing upon Applicants the wrong interpretation of MPEP §1412.01. Therefore, the Examiner is respectfully requested to reread MPEP §1412.01 and the corresponding statute 35 USC §251 and seek guidance from other Examiners in this area. Accordingly reconsideration and withdrawal of the 35 USC §251 rejection of claims 44-66 is respectfully requested.

Claims 44-66 stand rejected under 35 USC §103 as being unpatentable over Graciotti in view of Takenaka and Pinkham. This rejection is traversed for the following reasons. Applicants submit that the features of the present invention as now recited in claims 44-66 are not taught or suggested

by Graciotti, Takenaka or Pinkham whether taken individually or in combination with each other as suggested by the Examiner. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

As described above, amendments were made to the claims in order to more clearly recite that the forming of N bits of data using the successive bits of M bits of data and supplying the N bits of data in parallel to the data processor through the second bus is based on an indication from the data processor and the converting of the graphic data temporarily stored in the storage into serial data which is provided to the output means is performed in response to an indication from the data processor. These features are not taught or suggested by Graciotti, Takenaka or Pinkham whether taken individually or in combination with each other as suggested by the Examiner.

Further, numerous other features of the present invention are not taught or suggested by Graciotti, Takenaka or Pinkham whether taken individually or in combination with each other as suggested by the Examiner. In this regard Applicants refer the Examiner to the arguments set forth in the December 18, 1996 Amendment and the December 22, 1992 Amendment. Therein it was shown that Graciotti does not teach or suggest numerous features of the present invention as recited in the claims, particularly, in regard to the successive retrieval from memory of successive groups of M bits of data during a predetermined period of time, the converting of the graphic data temporarily stored in the

storage into serial data which is provided to the output means and other features.

The Examiner admits the deficiencies of the features and numerous other features in the Graciotti reference and attempts to supply these deficiencies by combining Graciotti with Takenaka and Pinkham. However, the Examiner has not shown any objective teaching in any of the references as to how the teachings of each of the references can be combined in the manner alleged by the Examiner. The Examiner has merely provided his own reasons as to how the references can be combined without pointing to any specific objective teachings in each of the references individually that such combination can be made as alleged by the Examiner.

In fact the Examiner makes broad statements as to what one of ordinary skill in the art would have known in order to modify the Graciotti, Takenaka and Pinkham references in order to meet the limitations of the present invention as recited in the claims. These modifications alleged by the Examiner which would have been known by one of ordinary skills in the art are merely fabrications on the part of the Examiner using his current understanding that are not supported by any teaching in any of the references of record.

Further, the alleged knowledge by one of ordinary skill in the art has not been related by the Examiner to what would have been known by one of ordinary skill in the art at the time of Applicants' invention. The Examiner's allegation of knowledge and modifications that one of

ordinary skill in the art would make are all based on the Examiner's current knowledge not proven knowledge existing prior to Applicants' invention.

Still further, In fact the Examiner is relying upon the teachings in Applicants' disclosure in order to make the combination (hindsight). Had it not been for the disclosure in the present application the Examiner nor one of ordinary skill in the art would have been led to combine the references in the manner alleged by the Examiner since no evidence that such a combination can be made exists.

One particular combination that the Examiner alleges can be made that seems particularly impossible is the combining of Graciotti with Pinkham in order to provide a converter as recited in each of the claims. The Examiner recognizes that "Graciotti does not explicitly disclose the claimed conversion means". However, the Examiner alleges that such is known in the art as taught by Pinkham. However, the disclosure pointed to by the Examiner in Pinkham could not have been combined with the Graciotti circuitry in the manner alleged by the Examiner since the connections are totally incompatible and the purposes behind each of the respective circuits disclosed by Graciotti and Pinkham are entirely different. The combination alleged by the Examiner can not be made and is merely the Examiner's fabrication not supported by either of the disclosures. The Examiner is merely relying on Applicants' disclosure which provides the need for a converter and then finds Pinkham having an alleged teaching of a converter to supply the

need. The need for a converter arose in Applicants' invention not in Graciotti since it was never Graciotti's intention to provide such an element. Thus, the Examiner is being guided by Applicants' disclosure.

Further, the alleged converter in Pinkham does not perform the conversion recited in the claims of the present application. The conversion recited in the claims of the present application provides for the conversion of the graphic data temporarily stored in the storage of the memory controller into serial data which is provided to an output means. This element corresponds to element 40 illustrated in Fig. 1 of the present application. The alleged converter in Pinkham does not perform such a function nor is it intended to be combined with apparatus such as that taught in Graciotti. Therefore, the combination as alleged by the Examiner would be impossible.

Further, the Examiner still has not addressed the limitation in the claims regarding the successive retrieval from memory of successive groups of M bits of data during a predetermined period of time. The Examiner merely states in paragraph 7 of the Office Action that "this argument is moot in view of the new grounds of rejection". However, the new grounds of rejection still has yet to address these features of the present invention. At no point in the rejection of the claims under 35 USC §103 as being unpatentable over Graciotti, Takenaka or Pinkham did the Examiner state specifically where in the Graciotti, Takenaka or Pinkham references can be found the features of the present

invention wherein successive retrievals are performed from memory of successive groups of M bits of data during a predetermined period of time. The Examiner is specifically requested to point to where in the references of record such teaching can be found since this is a specific limitation in the claims which as of yet has not been addressed by the Examiner.

Numerous other features of the present invention have not been addressed by the Examiner. For example, claim 59 is directed to a memory controller having M bit terminals, an N bit interface, at least one bit terminal, first converting means and second converting means. The Examiner has not shown where any of these elements are shown in any of the references of record.

Claim 63 recites a memory controller having M bit terminals, N bit terminals, a storage, means for performing and supplying and converting means. The Examiner has not shown where any of the features recited in claim 63 are taught or suggested by any of the references of record.

Further in this regard, claims 60 and 61, which depend from claim 59, recite further features regarding the first converting means. The Examiner has not shown at any point in the Office Action where the further features of the first converting means recited in claims 60 and 61 can be found in the references of record.

Claim 62 recites further features regarding the second converting means. The Examiner has not shown where any of the further features of the second converting means are

taught or suggested by any of the references of record.

Claims 64-66 depend from claim 63 which recite further features regarding the successive transferring of data. The Examiner has now shown where the successive retrieval of M bits of data is taught or suggested by the references of record yet alone the further features regarding the successive retrieval of data recited in claims 64-66.

Therefore, it is quite clear that the Examiner has not given a fully and complete examination of the present application specifically considering each of the limitations recited in the claims.

Accordingly, the 35 USC §103 rejection of claims 44-66 should be reconsidered and withdrawn.

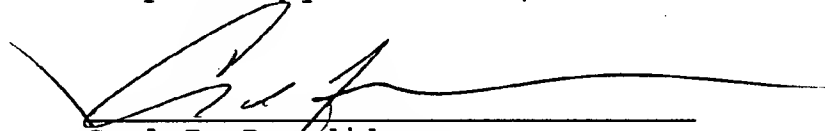
The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the reference utilized in the rejection of the claims.

In view of the foregoing amendments and remarks, Applicants submit that claims 44-66 are in condition for allowance. Accordingly, early allowance of claims 44-66 is respectfully requested.

To the extent necessary, applicants petition for an extension of time under 37 C.F.R. section 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to

Deposit Account No. 01-2135 (Case No. 500.26967R00) and
please credit any excess fees to such Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Carl I. Brundidge', is written over a horizontal line.

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